

REMARKS*Claim Status:*

Claims 21-28 are pending in the application. Dependent claim 28 is newly presented.

Formal Rejection:

Claims 21-27 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office Action suggests that applicant was not in possession of embodiments combining features of the instant application with features of the 09/571,422 application.

We respectfully traverse these rejections.

For example, applicant expressly contemplated combining described embodiments with those incorporated by reference: *“It should be recognized that the particular combinations of elements and features in the above-detailed embodiments are exemplary only; the interchanging and substitution of these teachings with other teachings in this and the incorporated-by-reference patents/applications are also contemplated.”* See the application, page 4, lines 22-25.

Withdrawal of these rejections is requested.

Art-based Rejection:

Claims 21-27 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,947,571 (“Rhoads”). We respectfully traverse these rejections.

It is well settled that in order for an Office Action to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. See generally, *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

The final Office Action does not establish a *prima facie* case of anticipation since Rhoads does not have each and every element of claim 21 as arranged therein; namely, it does not have in software instructions in said memory causing said processor *to establish a layered stack of protocols*, in combination with the other features of claim 21.

The Office Action apparently cites to Rhoads at Col. 45, lines 34-35 for these features. See the Office Action, page 5, lines 4-9. We respectfully disagree with this analysis.

For convenience, these Rhoads passages are reproduced below:

“[In this as in other embodiments, the decoding can be effected by dedicated] hardware, by decoding software executing on a general purpose CPU, etc.”

We are confused by this citation. For example, we do not see a discussion of software instructions in said memory causing said processor *to establish a layered stack of protocols* in the manner claimed.

Thus, Rhoads does not have each and every feature of the claim as arranged therein.

Withdrawal of this rejection is respectfully requested.

Inventorship-based Rejections:

Claims 21-27 are rejected under 35 U.S.C. §102(f) because the applicant did not invent the claimed subject matter. The Office Action relies on its rejection, above, under 35 U.S.C. §102(e) to support this rejection since “the claimed subject matter is entirely directed to the contents disclosed in the Rhoads[...] patent”. See the Office Action, page 6, under paragraph 6.

We respectfully traverse these rejections.

As noted above, Rhoads does not have each and every limitation of the claims. Thus, it fails to anticipate the claims. As such, the basis for the 35 U.S.C. §102(f) rejections also fails.

Conclusion:

Favorable reconsideration and passage to issue are solicited. In the meantime, the Examiner is respectfully reminded of our request for an interview on page 4 above.

Date: January 20, 2010

Customer Number 23735

Phone: 503-469-4685

FAX: 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By: /Steven W. Stewart, Reg. No. 45,133/
Steven W. Stewart
Registration No. 45,133